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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/471,669	12/24/1999	JOHN P. ANDERSON	00228-US-NEW	7795

21835 7590 07/16/2002

ELAN PHARMACEUTICALS, INC.  
INTELLECTUAL PROPERTY DEPARTMENT  
800 GATEWAY BOULEVARD  
SOUTH SAN FRANCISCO, CA 94080

EXAMINER
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WALICKA, MALGORZATA A

ART UNIT	PAPER NUMBER
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1652

DATE MAILED: 07/16/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/471,669

Applicant(s)

ANDERSON ET AL.

Examiner

Malgorzata A. Walicka

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE \_\_\_\_ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 May 2002.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-48 and 51-113 is/are pending in the application.
- 4a) Of the above claim(s) 1-47 and 70-113 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 48 and 51-69 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All   b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 6) ☒ Other: *See Continuation Sheet*.

Continuation of Attachment(s) 6). Other: Copies of the US Patent No.6,319,689 B1 and EP 085544 A2 .

The Amendment filed on May 1, 2002 as paper No. 16 is acknowledged. Amendments to the specification and claims have been entered. Claims 49 and 50 are cancelled. Claims 1-48 and 51-113 are pending. Claims 1-47 and 70-113 are withdrawn from consideration as drawn to the non-elected invention. Claims 48 and 51 - 69 are the subject of this Office Action.

## **Detailed Office Action**

### **1. Objections**

#### **1.1. Specification**

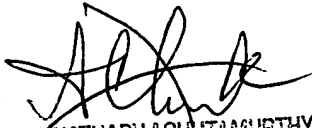
The objections to the specification made in the previous Office Action, paper No. 13, are withdrawn due to the Applicants' amendments.

#### **1.2. Claims**

Objections to claims 51 and 66 made in the previous Office Action, paper No. 13, are withdrawn because the claims have been amended. However, claim 63 encompasses the redundant text "[1-501]" that should be deleted. In addition, the names APP, APPwt and APPsw in claims 67 and 68 should be expanded because they are used in the claims for the first time.

### **2. Rejections**

#### **2.1. 35 U.S.C. 112, second paragraph**

  
POORNATHAPUACHARYA MURTHY  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

Rejection of claims 62, 63 and 68 made in the previous Office Action, paper No. 13, are withdrawn because the claims have been amended. However, amendments necessitate rejection of claim 65, 66 and 69. Claims 65 and 66 recite the limitation "said  $\beta$ -secretase protein". There is insufficient antecedent basis for this limitation in claim 64 from which claims 65 and 66 depend. Claim 69 also depends on claim 64 and recites the limitation "said  $\beta$ -secretase-cleavable fragment", whereas the base claim does not recite any  $\beta$ -secretase-cleavable fragment.

**2.2. 35 U.S.C. 112, first paragraph**

Rejection of claim 48, made in the previous Office Action, paper No. 13, is withdrawn because the claim has been amended.

**2.3. 35 U.S.C. 102**

Rejection of claims 48 and 51-57 under 35 U.S.C. 102 made in the previous Office action, paper No. 13, is withdrawn because the claims have been amended.

**2.4. Rejection under 35 USC 103(a)**

Rejection of claims 58-63 under 35 U.S.C. 103(a) in part concerning DNA encoding SEQ ID NO: 2 is withdrawn.

In response to the previous Office action, paper No. <sup>5</sup>13, Applicants write that Powell et al. in EP 0855 444 A2 do not teach SEQ ID NO: 2. However, the copies of pages 18-20 of EP 0855 444 A2 prove evidence that amino acid SEQ ID NO: 2 of the

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EP 0855 444 A2 is identical to the amino acid sequence of SEQ ID NO: 2 of the instant Application. Nevertheless, it is evident that SEQ ID NO: 1 of EP 0855 444 A2 does not encode SEQ ID NO: 2 of the EP 0855 444 A2, because the codon of SEQ ID NO: 1 that contains adenine in position 389 should be translated as glutamic acid and not valine. Powell et al., made, therefore, a mistake in translation; the mistake was corrected in the US Patent No. 6,319,689 B1, copy enclosed. In the light of these facts EP0855444A2 is not a prior art for the instant invention.

#### ***2.4. Statutory double patenting***

Claims 48, 51-62 and 64-69 remain, in part concerning DNA encoding polypeptides of SEQ ID NO: 58, SEQ ID NO: 74, SEQ ID NO: 75, SEQ ID NO: 69, SEQ ID NO: 67, SEQ ID NO: 66, and SEQ ID NO: 43, are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 56 and 61-77, of copending Application No. 09/501,708 (**708**) filed on February 10, 2000. Claims 56 and 61-77 of **708** are directed to the DNA, expression vectors, transformed cells and method of recombinant production of polypeptides having identical amino acid sequences to those of the instant application. Both sets of claims are directed to the same subject matter and have the same scope. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

### **3. Conclusion**

**No claim is allowed.**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Malgorzata A. Walicka, Ph.D., whose telephone number is (703) 305-7270. The examiner can normally be reached Monday-Friday from 10:00 a.m. to 4:30 p.m.

If attempts to reach examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura Achutamurthy, Ph.D. can be reached on (703) 308-3804. The fax phone number for this Group is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionists whose telephone number is (703) 308-0196.

Malgorzata A. Walicka, Ph.D.  
Art Unit 1652  
Patent Examiner

  
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